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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/578,168	05/22/2000	Elizabeth Ifukhar	0198	5023
32366	7590	07/23/2008		
BRUCE E. WEIR 12 SPARROW VALLEY COURT MONTGOMERY VILLAGE, MD 20886-1265			EXAMINER FERNSTROM, KURT	
			ART UNIT	PAPER NUMBER
			3711	
			MAIL DATE	DELIVERY MODE
			07/23/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/578,168

Applicant(s)

IFTIKHAR, ELIZABETH

Examiner

Kurt Fernstrom

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 2 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

According to the "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (1300 OG 142, 22 November 2005), the analysis for determining patent eligible subject matter under §101 can be said to be subject to the following criteria:

1. Does the claimed invention fall within one of the four statutory categories (process, machine, manufacture or composition of matter)? If the answer to this criterion is no, then the claimed invention is not statutory eligible subject matter.
2. If the answer is yes to the first criterion, then does the claimed invention fall within a judicial exception? If the answer to this criterion is no, then the claimed invention would be statutory eligible subject matter.
3. If the answer is yes to the second criterion, then does the claimed invention provide a practical application of the judicial exception? If the answer to this criterion is yes, then the claimed invention would be statutory eligible subject matter, unless the claimed invention effectively preempts all substantial practical applications of the judicial exception, in

which case the claimed invention would not be statutory eligible subject matter.

4. If the answer to the third criterion is no, then the claimed invention is not statutory eligible subject matter and is not eligible for patent protection.

With regards to the first criterion, the claimed invention is a method for enhancing receptive language comprising performing various steps of presenting visual images and correlated audio. Certainly, the steps recited can be considered a "process" and therefore broadly falls within one of the four statutory categories of invention.

However, regarding the second criterion it is well settled that claims directed to nothing more than abstract ideas, natural phenomenon, and laws of nature (i.e. judicial exceptions) are not eligible and therefore are excluded from patent protection. Diehr, 450 U.S. at 185, 209 USPQ at 7; accord, e.g., Chakrabarty, 447 U.S. at 309, 206 USPQ at 197; Parker v. Flook, 437 U.S. 584, 589, 198 USPQ 193, 197 (1978); Benson, 409 U.S. at 67-68, 175 USPQ at 675; Funk, 333 U.S. at 130, 76 USPQ at 281. "A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right." Le Roy, 55 U.S. (14 How.) at 175. Instead, such "manifestations of laws of nature" are "part of the storehouse of knowledge," "free to all men and reserved exclusively to none." Funk, 333 U.S. at 130, 76 USPQ at 281. In this case, the method steps recited are merely the manipulation of abstract ideas. It is the examiner's position that such manipulation of abstract ideas broadly falls into the above noted exclusions.

For claims including such excluded subject matter to be eligible, according to the third criterion the claim must be for a practical application of the abstract idea, law of nature, or natural phenomenon. Diehr, 450 U.S. at 187, 209 USPQ at 8 (“application of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.”); Benson, 409 U.S. at 71, 175 USPQ at 676 (rejecting formula claim because it “has no substantial practical application”). A practical application of the § 101 judicial exception can be identified in various ways:

- The claimed invention “transforms” an article or physical object to a different state or thing; or
- The claimed invention otherwise produces a useful, concrete and tangible result, based on the factors discussed below.

In this case, the recited steps do not result in a transformation of an article or physical object to a different state or thing. All that is claimed is a teaching method comprising presenting information to a child. Therefore, the judicial exception recited in the claims is not practically applied via a transformation.

For eligibility analysis, physical transformation “is not an invariable requirement, but merely one example of how a mathematical algorithm [or law of nature] may bring about a useful application.” AT&T, 172 F.3d at 1358-59, 50 USPQ2d at 1452. If the examiner determines that the claim does not entail the transformation of an article, then the examiner shall review the claim to determine if the claim provides a practical application that produces a useful, tangible and concrete result. In order to be considered patent eligible under 35 USC 101, a claimed process must either result in a

physical transformation or contain a sufficient tie to a machine, article of manufacture or a composition of matter. In re Comiskey, 84 USPQ2d 1670 (Fed. Cir. 2007). In this case, while specification discusses the use of certain apparatuses in performance of the method, none of these apparatuses are recited in the claims. An "image" is not an apparatus, as it can be presctned in numerous ways - on a paper, on a computer, projected onto a wall, and so forth. Thus, claims 1 and 2 do not contain a sufficient tie to a machine, article of manufacture or a composition of matter under Comiskey, and thus are not patent eligible under 35 USC 101.

Applicant is advised that amendment to the claims to include a sufficient tie to another statutory category of patentable subject matter in a way supported by the original specification would overcome this rejection, and place the claims in condition for allowance.

Response to Arguments

Applicant's arguments with respect to claims 1 and 2 have been considered but are moot in view of the new ground(s) of rejection. Because new grounds of rejection are presented herein, and were not necessitated by amendment, this action is made non-final.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (571) 272-4422. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kurt Fernstrom/
Primary Examiner, Art Unit 3711

July 21, 2008

Application Number**Application/Control No.**

09/578,168

**Applicant(s)/Patent under
Reexamination**

IFTIKHAR, ELIZABETH

Examiner

Kurt Fernstrom

Art Unit

3711